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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/703,858	11/01/2000	Brian Kevin Daly	2000-0063	3715

24197 7590 11/24/2003

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EXAMINER

GARY, ERIKA A

ART UNIT	PAPER NUMBER
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2681

DATE MAILED: 11/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/703,858

Applicant(s)

DALY, BRIAN KEVIN

Examiner

Erika A. Gary

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on October 20, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Allowable Subject Matter***

1. The indicated allowability of claims 7 and 8 is withdrawn in view of the newly discovered reference(s) to Daly, US patent Number 6,122,503. Rejections based on the newly cited reference(s) follow.

### ***Drawings***

2. The corrected drawings were received on October 20, 2003. These drawings are acceptable.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-6, and 10-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Chatterjee et al., US Patent Number 6,282,421 (hereinafter Chatterjee).

Regarding claim 1, Chatterjee discloses a method of activating a mobile station for communicating with a telecommunications network, comprising the steps of: (a) in a

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first registration, providing the mobile station with a permanent mobile station ID [fig. 5]; (b) in a second registration, receiving the permanent mobile station ID from the mobile station [fig. 6]; and (c) communicating programming data to the mobile station [figs. 5, 6].

Regarding claim 2, Chatterjee discloses the first registration comprises the steps of receiving a temporary activation mobile station ID from a mobile station; verifying the temporary activation mobile station ID; and communicating a permanent mobile station ID to the mobile station [fig. 5; col. 9: line 59 – col. 10: line 28].

Regarding claim 3, Chatterjee discloses the second registration comprises the steps of: receiving the permanent mobile station ID from the mobile station; verifying the permanent mobile station ID; and communicating programming data to the mobile station [fig. 6; col. 10: lines 29-51].

Regarding claim 4, Chatterjee discloses a method of activating a mobile station for communicating with a telecommunications network, comprising the steps of: of receiving a temporary activation mobile station ID from a mobile station; verifying the temporary activation mobile station ID; communicating a permanent mobile station ID to the mobile station [fig. 5; col. 9: line 59 – col. 10: line 28]; receiving the permanent mobile station ID from the mobile station; verifying the permanent mobile station ID; and communicating programming data to the mobile station [fig. 6; col. 10: lines 29-51].

Regarding claim 5, Chatterjee suggests receiving the temporary activation mobile station ID (it is inherent in the art to also send the ESN) of the mobile station at a mobile switching center, and sending a registration notification to an over-the-air activation

function; and sending a registration notification containing the permanent mobile station ID from the over-the-air activation function to the mobile switching center [fig. 5; col. 9: line 59 – col. 10: line 28].

Regarding claim 6, Chatterjee suggests receiving the permanent mobile station ID (it is inherent in the art to also send the ESN) from the mobile station at the mobile switching center; and the mobile switching center sending a registration notification to a home location register assigned to the permanent mobile station ID [fig. 6; col. 10: lines 29-51].

Regarding claim 10, Chatterjee discloses a method of activating a mobile station in a wireless network, comprising: transmitting a permanent mobile station ID from the wireless network to the mobile station; transmitting the permanent mobile station ID from the mobile station to the network; and communicating programming data to the mobile station in response to the transmission of the permanent mobile station ID by the mobile station [figs. 5, 6].

Regarding claim 11, Chatterjee discloses storing subscription information for a subscriber in a customer database; and assigning the permanent mobile station ID to the subscriber associated with the subscription information [col. 2: lines 23-31].

Regarding claim 12, Chatterjee discloses the permanent mobile station ID is a permanent MIN [col. 10: lines 35-37].

Regarding claim 13, it is inherent for a permanent mobile station ID to be a permanent IMSI based on the type of wireless network.

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Regarding claim 14, Chatterjee discloses the programming data communicated to the mobile station includes at least one number assignment module (NAM) parameter [col. 7: lines 33-35].

Regarding claim 15, it is inherent to store the at least one NAM parameter in the mobile station.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chatterjee in view of Daly, US Patent Number 6,122,503 (hereinafter Daly).

Claim 7 depends on claim 6. As discussed above, Chatterjee discloses the limitations of claim 6. What Chatterjee does not specifically disclose are the additional programming steps of claim 7. However, Daly teaches these limitations.

Daly discloses a method for over the air programming of telecommunication services comprising an over-the-air activation function sending programming data to the mobile switching center identified by the home location register; the mobile switching center sending a SPACH notification of R-data to the mobile station; the mobile switching center receiving SPACH confirmation from the mobile station; the mobile switching center sending programming data to the mobile station; the mobile switching

center receiving from the mobile station an acknowledgement of receipt of the programming data; and the mobile switching center notifying the over-the-air activation function of a successful download of programming data to the mobile station [fig. 12; col. 9: line 63 – col. 10: line 27].

Chatterjee and Daly are combinable because they are from the same field of endeavor, that is, over-the-air programming of telecommunication services. At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify Chatterjee to include Daly. The motivation for this modification would have been to specifically point out the programming messages well known in the art when performing control functions.

7. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chatterjee in view of Daly.

Regarding claims 8 and 9, Chatterjee discloses a method of activating a mobile station for communicating with a telecommunications network, comprising the steps of: (a) receiving a temporary activation mobile station ID and an ESN from a mobile station, wherein the temporary activation mobile station ID and the ESN are received at a mobile switching center, and a registration notification is sent to an over-the-air activation function; (b) verifying the temporary activation mobile station ID, wherein a registration notification containing the permanent mobile station ID is sent from the over-the-air activation function to the mobile switching center; (c) communicating a permanent mobile station ID to the mobile station [fig. 5; col. 9: line 59 – col. 10: line

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28]; (d) receiving the permanent mobile station ID and ESN from the mobile station at the mobile switching center; (e) verifying the permanent mobile station ID, wherein a registration notification is sent by the mobile switching center to a home location register assigned to the permanent mobile station ID; and (f) communicating programming data to the mobile station [fig. 6; col. 10: lines 29-51] .

What Chatterjee does not specifically disclose are the additional programming steps of claims 8 and 9. However, Daly teaches these limitations.

Daly discloses a method for over the air programming of telecommunication services comprising an over-the-air activation function wherein: the over-the-air activation function sends programming data to the mobile switching center identified by the home location register; the mobile switching center sends a SPACH notification of R-data to the mobile station; the mobile switching center receives SPACH confirmation from the mobile station; the mobile switching center sends programming data to the mobile station; the mobile switching center receives from the mobile station an acknowledgement of receipt of the programming data; and the mobile switching center notifies the over-the-air activation function of a successful download of programming data to the mobile station [fig. 12; col. 9: line 63 – col. 10: line 27].

Chatterjee and Daly are combinable because they are from the same field of endeavor, that is, over-the-air programming of telecommunication services. At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify Chatterjee to include Daly. The motivation for this modification would have been to



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specifically point out the programming messages well known in the art when performing control functions.

### ***Response to Arguments***

8. Applicant's arguments filed October 20, 2003 have been fully considered but they are not persuasive. Applicant argues that Chatterjee does not teach the first and second registrations. However, the Examiner respectfully disagrees. Chatterjee discloses a first registration wherein a temporary activation mobile station ID is received (the dummy MIN). Once this ID is verified, the mobile station receives a permanent ID. Chatterjee further teaches a second registration (i.e. activation in a new area) wherein the permanent mobile station ID is received. Subsequent to this, the mobile station receives programming data. Hence, the claim limitations are read in the reference.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Findikli et al., US Patent Number 6,594,482 disclose controlled transmission of wireless communications device identity.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erika A. Gary whose telephone number is 703-308-

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0123. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh N. Tran can be reached on 703-305-4040. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4750 or to the 2600 Customer Service Office at 703-306-0377.

**Any response to this action should be mailed to:**

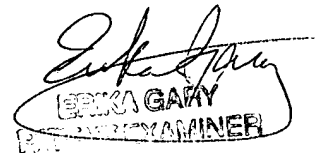
Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

(703) 872-9306 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal  
Drive Arlington, VA., Sixth Floor (Receptionist).

EAG  
November 17, 2003



ERIKA GARY  
REGISTERED EXAMINER